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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,153	08/21/2003	Jeong-Kyu Moon	678-1123 (P10535)	8920
66547 7590 04/30/2008 THE FARRELL LAW FIRM, P.C. 333 EARLE OVINGTON BOULEVARD SUITE 701 UNIONDALE, NY 11553				
EXAMINER				
DESIR, PIERRE LOUIS				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
04/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/646,153

**Applicant(s)**

MOON, JEONG-KYU

**Examiner**

PIERRE-LOUIS DESIR

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 4-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 of Application No. 10/903957. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 4 and 8 are a broader version of claims 1 and 9 of copending Application No. 10/903957.

Claim 4 of the present invention discloses a method for performing a one-touch call operation using a mobile terminal, comprising the steps of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal; and if the call connection between the mobile terminal and the counterpart mobile terminal is not established, pressing a one-touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message to the counterpart mobile terminal.

Claims 1 of the copending application discloses a mobile communication terminal comprising a key input unit including a one-touch message key, the key input unit outputting a signal requesting one-touch message transmission when the one-touch message key is pressed after a telephone-number is pressed; and a control unit for sending the stored message

corresponding to the one-touch message key when a user inputs a demand for one-touch message transmission.

However, claim 1 of the copending application further discloses that the mobile terminal comprises a display unit for displaying menus for one-touch message transmission; a memory for storing a message corresponding to the one-touch message key.

Nonetheless, the removal of said limitations from claim 4 of the present application made claim 4 a broader version of claim 1. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (In re Karlson (CCPA) 136 USPQ 184 (1963)), claim 4 is not patentably distinct from claim 1.

Claim 4 of the present invention discloses a method for performing a one-touch call operation using a mobile terminal, comprising the steps of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal; and if the call connection between the mobile terminal and the counterpart mobile terminal is not established, pressing a one-touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message to the counterpart mobile terminal.

Claims 9 of the copending application discloses a mobile communication terminal for one-touch message transmission comprising a key input unit including a one-touch message key, the key input unit outputting a signal requesting one-touch message transmission when the one-

touch message key is pressed after a telephone-number is pressed; and a control unit for sending the stored message corresponding to the one-touch message key when a user inputs a demand for one-touch message transmission.

However, claim 9 of the copending application further discloses that the mobile terminal comprises a display unit for displaying menus for one-touch message transmission; a memory for storing messages corresponding respectively to the plurality of one touch message keys

Nonetheless, the removal of said limitations from claim 4 of the present application made claim 4 a broader version of claim 1. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson* (CCPA) 136 USPQ 184 (1963)), claim 4 is not patentably distinct from claim 9.

Claim 8 of the present application discloses a method for performing a one-touch call operation using a mobile terminal, comprising the steps of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal; if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal; and transmitting, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal and a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal.

Claims 1 of the copending application discloses a mobile communication terminal comprising a key input unit including a one-touch message key, the key input unit outputting a

signal requesting one-touch message transmission when the one-touch message key is pressed after a telephone-number is pressed; and a control unit for sending the stored message corresponding to the one-touch message key when a user inputs a demand for one-touch message transmission.

However, claim 1 of the copending application further discloses that the mobile terminal comprises a display unit for displaying menus for one-touch message transmission; a memory for storing a message corresponding to the one-touch message key.

Nonetheless, the removal of said limitations from claim 4 of the present application made claim 4 a broader version of claim 1. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson* (CCPA) 136 USPQ 184 (1963)), claim 4 is not patentably distinct from claim 1.

Claim 8 of the present application discloses a method for performing a one-touch call operation using a mobile terminal, comprising the steps of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal; if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal; and transmitting, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal and a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal.

Claims 9 of the copending application discloses a mobile communication terminal for one-touch message transmission comprising a key input unit including a one-touch message key, the key input unit outputting a signal requesting one-touch message transmission when the one-touch message key is pressed after a telephone-number is pressed; and a control unit for sending the stored message corresponding to the one-touch message key when a user inputs a demand for one-touch message transmission.

However, claim 9 of the copending application further discloses that the mobile terminal comprises a display unit for displaying menus for one-touch message transmission; a memory for storing messages corresponding respectively to the plurality of one touch message keys

Nonetheless, the removal of said limitations from claim 4 of the present application made claim 4 a broader version of claim 1. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (In re Karlson (CCPA) 136 USPQ 184 (1963)), claim 4 is not patentably distinct from claim 9.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person



having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-5, 7-8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al. (Wheeler), U.S. Patent No. 6639973, in view of Oda, U.S. Patent No. 5703932.

Regarding claim 4, Wheeler discloses a method comprising the step of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal (i.e., an originating party places a call through an originating party call control, through a network, through a terminating party call control to a terminating subscriber) (see abstract); and if the call connection between the mobile terminal and the counterpart mobile terminal is not established, transmits, using information entered during the attempt to establish the call connection, a predetermined message to the counterpart mobile terminal (i.e., in a situation where the terminating party computer is not available, the originating party through call treatment rule set send a pre-stored message is sent) (see col. 2, lines 40-55, and col. 4, lines 37-59).

Although Wheeler discloses a method as described, Wheeler does not specifically disclose a method comprising pressing a one-touch call button of the mobile terminal.

However, Oda discloses a method wherein when a one touch transmission setting is established using the one touch setting switch provided on the rear face side of the case, it becomes possible to transmit signals by one touch to a desired address by just operating either one of operation keys provided on the front side of the case (see col. 2, lines 5-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings as described by Oda with the teachings described by Wheeler to arrive at the claimed invention. A motivation for doing so would have been to provide an

enhance service to the user by the saving he/she precious amount of time and to facilitate the sending of messages to the destination party.

Regarding claim 8, Wheeler discloses a method comprising the step of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal (i.e., an originating party places a call through an originating party call control, through a network, through a terminating party call control to a terminating subscriber) (see abstract); and if the call connection between the mobile terminal and the counterpart mobile terminal is not established, transmits, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal (as known in the art, the identification of the calling party is sent to the called party when a call connection is made) and a predetermined message to the counterpart mobile terminal (i.e., in a situation where the terminating party computer is not available, the originating party through call treatment rule set send a pre-stored message is sent) (see col. 2, lines 40-55, and col. 4, lines 37-59).

Although Wheeler discloses a method as described, Wheeler does not specifically disclose a method comprising pressing a one-touch call button of the mobile terminal.

However, Oda discloses a method wherein when a one touch transmission setting is established using the one touch setting switch provided on the rear face side of the case, it becomes possible to transmit signals by one touch to a desired address by just operating either one of operation keys provided on the front side of the case (see col. 2, lines 5-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings as described by Oda with the teachings described by Wheeler to arrive at the claimed invention. A motivation for doing so would have been to provide an

enhance service to the user by the saving he/she precious amount of time and to facilitate the sending of messages to the destination party.

Regarding claim 5, Wheeler discloses a method (see claim 4 rejection) which includes the steps of: reading out a phone number of the mobile terminal (i.e., pre-stored phone number) and the predetermined message (i.e., pre-stored text message) from a memory of the mobile terminal (see col. 2, lines 45-55, also refer to col. 1, lines 3-10); and simultaneously transmitting the phone number of the mobile terminal and the predetermined message to the counterpart mobile terminal (i.e., in a situation where the terminating party computer is not available, the originating party through call treatment rule set send a pre-stored message is sent) (see col. 2, lines 40-55, and col. 4, lines 37-59).

Although Wheeler discloses a method as described, Wheeler does not specifically disclose a method comprising pressing a one-touch call button of the mobile terminal.

However, Oda discloses a method wherein when a one touch transmission setting is established using the one touch setting switch provided on the rear face side of the case, it becomes possible to transmit signals by one touch to a desired address by just operating either one of operation keys provided on the front side of the case (see col. 2, lines 5-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings as described by Oda with the teachings described by Wheeler to arrive at the claimed invention. A motivation for doing so would have been to provide an enhance service to the user by the saving he/she precious amount of time and to facilitate the sending of messages to the destination party.

Regarding claim 7 and 10, Wheeler discloses a method (see claims 4 and 8 rejections) wherein the predetermined message is a previously entered text message (i.e., pre-stored text message) (see col. 4, lines 49-51).

5. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler and Oda, further in view of Moran, Pub. No. 20020073142.

Regarding claims 6 and 9, Wheeler and Oda discloses a method as described (see rejections as applied to claims 4 and 10).

Although the combination (Wheeler and Oda) discloses a method as described, the combination does not specifically disclose a method wherein a predetermined message is a previously recorded voice message.

However, Moran discloses a method wherein a predetermined message to be sent to a destination address is a pre-recorded voice or text message (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Moran (specified above) with the teachings of Wheeler and Oda to arrive at the claimed invention. A motivation for doing so would have been to provide a messaging system, which overcomes the tedious routine of repeating one's name, phone number, and time of call (see paragraph 3).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PIERRE-LOUIS DESIR whose telephone number is (571)272-7799. The examiner can normally be reached on Monday-Friday 9:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on (571)272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pierre-Louis Desir/  
Examiner, Art Unit 2617

/DWAYNE D. BOST/  
Supervisory Patent Examiner,  
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